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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,983	12/19/2001	Bartley Dean Maxon	DC4969	4816

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EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/024,983

Applicant(s)

MAXON ET AL.

Examiner

San-ming Hui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The cancellation of claims 1-6 filed April 10, 2002 is acknowledged. The addition of claims 7-12 filed April 10, 2002 is acknowledged.

The outstanding rejections of claims 1-6 under 35 USC 112, first paragraph have been withdrawn in view of the amendment filed April 10, 2002.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression "sorbitan derivatives, sucrose esters and their derivatives, and glucose esters and derivatives" in claim 7 renders the claims indefinite as to what derivative compounds are encompassed by the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling, Jr. et al. (US Patent 4,150,048), Schulz, Jr. et al. (US Patent 5,654,362 from the IDS received December 19, 2001), Remington (Remington's Pharmaceutical Sciences, 18<sup>th</sup> ed., 1990, page 1314), Zhang (US Patent 5,889,108) in view of Lin et al. (US Patent 6,207,717 B1 from the IDS received December 19, 2001).

Schilling, Jr. et al. teaches a linear silicone polyether, with polyoxyethylene or polyoxyethylene-polyoxypropylene copolymeric units grafted onto a silicone backbone which is useful as surfactant in the preparation of aerosol for shaving cream (See particularly the abstract; also col. 6, lines 2- col. 7, line 32; also col. 11, line 29-36). Schilling, Jr et al. teaches the weight percent of linear silicone polyether to be 0.5-2.0 (See particularly col. 13, line 12-13).

Schulz, Jr et al. teaches a  $\alpha,\omega$  -diene-crosslinked silicone elastomer, without oxyalkylene units, to be useful in silicone paste which can be used in the preparation of cosmetic products such as shaving lotion and facial cleansers (See particularly the abstract and claim 13). Schulz, Jr et al. teaches the weight percent of  $\alpha,\omega$  -diene-crosslinked silicone elastomer to be about 7.8% (See particularly col. 6, lines 42-65, Example III).

Remington teaches that polysorbate 20, also known as TWEEN 20, is a commonly used as a nonionic organic surfactant (See page 1314).

Zhang teaches decamethylcyclopentasiloxane, a thickening solvent, with a silicone elastomer or silicone paste are useful in preparation of emulsion useful for

LYNAROUS  
COL. 7  
LINES 32-33

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shaving lotion, shaving lathers or delivery systems of vitamins (See particularly the abstract, also col. 7, lines 12-29).

The references do not expressly teach the composition comprising the combination of linear silicone polyether,  $\alpha,\omega$ -diene-crosslinked silicone elastomer, and a nonionic organic emulsifier. The references do not expressly teach the composition comprising the combination of linear silicone polyether,  $\alpha,\omega$ -diene-crosslinked silicone elastomer, a nonionic organic emulsifier, decamethylcyclopentasiloxane, and vitamin E. The references do not expressly teach. The references do not expressly teach the weight percent of nonionic organic emulsifier to be 0.1-4.0.

Lin et al. teaches a water-in-oil emulsion comprising vitamin E and an elastmeric silicone polyether which can be used in the preparation of shaving soaps, shaving lotion, and shaving lathers (See particularly the abstract; also col. 12, line 14-15).

It would have been obvious to one skill in the art when the invention was made to employ linear silicone polyether,  $\alpha,\omega$ -diene-crosslinked silicone elastomer, polysorbate 20 (nonionic organic emulsifier), decamethylcyclopentasiloxane (a solvent), and vitamin E into a single composition. It would have been obvious to one skill in the art when the invention was made to employ the nonionic organic emulsifier in the weight percent herein claimed.

One of ordinary skill in the art would have motivated to employ linear silicone polyether,  $\alpha,\omega$ -diene-crosslinked silicone elastomer, polysorbate 20 (nonionic organic emulsifier), decamethylcyclopentasiloxane (a solvent), and vitamin E into a single composition because combining two or more agents which are known to be useful to

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formulate shaving creams and lotions individually into a single composition useful for the very same purpose is prima facie obvious. See *In re Kerkhoven* 205 USPQ 1069. One of ordinary skill in the art would have motivated to employ the nonionic organic emulsifier in the weight percent herein because The optimization of desired result effect parameters (e.g., the amount of the excipients such as surfactant) is obvious, as being within the skill of the artisan.

It is applicant's burden to demonstrate unexpected results over the prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). In the instant case, there is no data present in the case for evaluation of unexpected benefits. Therefore, no clear and convincing unexpected results are seen herein.

### ***Response to Arguments***

Applicant's arguments filed April 10, 2002 averring the cited prior art's failure to teach each components of the instant composition have been fully considered but they are not persuasive. As discussed above in the obviousness rejection, the cited prior art, as a whole, teaches every components of the instant composition. The motivation to

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combine all the components together is provided by the cited prior art that all the components are known to be useful in formulating shaving creams and lotions individually. Combining these components to prepare shaving creams and lotions would be *prima facie* obvious. See *In re Kerkhoven* 205 USPQ 1069.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

San-ming Hui  
July 15, 2002

  
RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200